

REMARKS

Applicants submit that by the present Amendment and Remarks, this application is placed in clear condition for immediate allowance. Applicants submit that the present Amendment merely makes explicit that which was implicit and, hence, does not generate any new matter issue or any new issue for that matter. Accordingly, entry of the present Amendment and Remarks, and favorable consideration, are respectfully solicited pursuant to the provisions of 37 C.F.R. §1.116.

Applicants would note that claims 1 through 21 are pending in this application, of which claims 13 through 20 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. §1.116. Applicants acknowledge, with appreciation, the Examiner's allowance of claims 6 through 12. Accordingly, the only remaining issue pivots about the patentability of claims 1 through 5 and 21.

Claims 1, 5 and 21 have been amended. Care has been exercised to avoid the introduction of new matter. Indeed, as previously mentioned, the present Amendment merely makes explicit that was implicit, i.e., that a single opening is formed entirely within the first single dielectric layer, as should be apparent from the arguments previously advanced as well as the embodiment illustrated in Figs. 1 through 6 and the related discussion thereof in the written description of the specification. Applicants submit that the present Amendment does not generate any new matter issue or any new issue for that matter.

Claims 1, 2, 4, 5 and 21 were rejected under 35 U.S.C. §102 for lack of novelty as evidenced by Chooi et al.

In the statement of the rejection, the Examiner referred to Figs. 1, and 4 through 8 of Chooi et al., as well as various portions of the text, asserting the disclosure of a method corresponding to that claimed. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of a claimed invention such that that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Elan Pharmaceuticals Inc. v. Mayo Foundation*, ____ F.3d ___, 64 USPQ2d 1292 (Fed. Cir. 2002); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). There is a fundamental difference between the claimed method and the methodology of Chooi et al. that scotches the factual determination that Chooi et al. identically describe the claimed invention within the meaning of 35 U.S.C. §102.

Specifically, and even without the present Amendment, previously rejected independent claim 1 was directed to a method comprising a sequence of manipulative steps wherein a first opening is formed in a first dielectric layer, which opening is "defined by side surfaces of the first dielectric layer and a bottom". No such method is disclosed or suggested by Chooi et al. who relate to a **dual** damascene technique vis-à-vis the single damascene technique of the claimed invention. So much should be apparent from Figs. 1 and 4 through 8 of Chooi et al. relied upon by the Examiner.

In the second full paragraph on page 3 of the March 24, 2003 Final Office Action, the Examiner asserts that opening 22 formed in dielectric layer 18 is defined by side

surfaces and a bottom of the first dielectric layer 18. This is not so. The opening 22 merely represents the trench portion of a dual damascene opening which also comprises via portion 24. There is no opening that is formed in what the Examiner has characterized as first dielectric layer 18 which is defined by the side surfaces of dielectric layer 18. This is a substantive difference because the claimed invention is directed to a single damascene technique; whereas, Chooi et al. clearly relate to a dual damascene technique.

Thus, even without the present Amendment, the imposed rejection under 35 U.S.C. §102 lacks sufficient facts. At any rate, in order expedite prosecution, Applicants have amended claim 1 to clarify that the opening is a single opening and is defined entirely by side surfaces of the first dielectric layer and bottom. As previously pointed out, Chooi et al. neither disclose nor suggest forming a single opening in a single dielectric layer defined entirely by side surfaces of that dielectric layer and a bottom.

The above difference in manipulative steps between the claimed method and the methodology of Chooi et al. undermines the factual determination that Chooi et al. disclose a method identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1, 2, 4, 5 and 21 under 35 U.S.C. §102 for lack of novelty as evidenced by Chooi et al. is not factually viable and, hence, solicit withdrawal thereof.

Claim 3 was rejected under 35 U.S.C. §103 for obviousness predicated upon Chooi et al. in view of Chung et al.

This rejection is traversed.

Specifically, claim 3 depends from independent claim 1. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. §102 for lack of novelty as evidenced by Chooi et al. Indeed, Chooi et al. neither disclose nor suggest a method corresponding to that defined in independent claim 1 which comprises etching to form a single opening defined entirely by side surfaces of the first dielectric layer and a bottom. The additional reference to Chung et al. does not cure the argued deficiencies of Chooi et al.

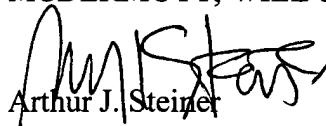
Applicants, therefore, submit that the imposed rejection of claim 3 under 35 U.S.C. §103 for obviousness predicated upon Chooi et al. in view of Chung et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Applicants again acknowledge, with appreciation, the Examiner's allowance of claims 6 through 12. Based upon the arguments submitted supra, it should be apparent that all active claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY


Arthur J. Steiner
Registration No. 26,106

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 AJS:ntb
Facsimile: (202) 756-8087
Date: May 20, 2003